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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,942	02/08/2005	Fred A. Antonini	0771MH-60032-US	8554
38441 7590 06/28/2007 LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			EXAMINER CHEVALIER, ALICIA ANN	
			ART UNIT 1772	PAPER NUMBER
			MAIL DATE 06/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,942	<b>Applicant(s)</b> ANTONINI, FRED A.	
	<b>Examiner</b> Alicia Chevalier	<b>Art Unit</b> 1772	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **RESPONSE TO AMENDMENT**

1. Claims 1-25 are pending in the application, claims 26-35 have been cancelled.
2. Amendments to the claims, filed on April 9, 2007, have been entered in the above-identified application.

### ***REJECTIONS***

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Double Patenting***

4. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 11/072382. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same film.

Application 11/072382 claims a film comprising a dimensionally stable, thin plastic film having a smooth surface finish, and a thin layer of silicone elastomer having a low durometer disposed on a first surface of the plastic film (*claim 1*).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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5. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/524367 in view of Braun et al. (U.S. Patent No. 5,300,171).

Application 10/524367 claims a film comprising a dimensionally stable, thin (*claim 2*) plastic film (*claim 24*) having a smooth surface finish, and a thin (*claim 2*) layer of silicone elastomer (*claims 17 and 19*) disposed on a first surface of the plastic film (*claims 1 and 20*).

Application 10/524367 fails to claim that the silicone has a low durometer.

Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to have a low durometer hardness such as less than 40 on a the Shore A hardness in order to insure flexibility.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "thin" in claim 1 is a relative term which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a "thin" film or layer, i.e. what dimensions are considered to be thin.

The term "low" in claim 1 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a "low" durometer, i.e. what values are considered to be low.

The term "smooth" in claim 7 is a relative term which renders the claim indefinite. The term "smooth" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what constitutes a "smooth" surface, i.e. is there surface 0.

The term "heavily" in claim 8 is a relative term which renders the claim indefinite. The term "heavily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

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apprised of the scope of the invention. It is unclear what constitutes a "heavily" textured, i.e. what is the number on projections per area or what is the surface roughness.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,372,323) in view of Braun et al. (U.S. Patent No. 5,300,171) and evidenced by Tokas et al. (U.S. Patent No. 6,960,272).

Regarding Applicant's claims 1 and 3, Kobe discloses a film comprising a plastic film (*additional backing layer, col. 5, lines 26-28 and 51-67*) and a silicone elastomer (*backing layer with stems, col. 5, lines 8-9 and col. 9, lines 48-49*) disposed on a first surface of the plastic film (*figure 1*). The plastic film is deemed to be thin (*col. 5, lines 35-36*) and dimensionally stable with a smooth surface, since figure 1 one shows the additional backing is flat, i.e. no texturing/projections, and is used to as a stabilizing layer (*col. 5, lines 26-27*). The silicone elastomer film is deemed to be thin (*col. 5, lines 35-36*). Kobe further discloses that the slip control article is flexible (*col. 1, lines 45-47*).

Kobe fails to disclose that the silicone elastomer has a low durometer, more specifically less than 40 on the Shore A scale.

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Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 40 on a the Shore A hardness in order to insure flexibility.

Regarding Applicant's claim 2, Kobe discloses that the plastic film can be made of thermoplastic elastomers, such as polyolefin (*col. 5, lines 60-61*). Tokas shows that thermoplastic elastomers with polyolefinic material has a low surface energy, such as 28-30 dynes/cm (*col. 2, line 12-22*).

The limitation "co-extruded" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant's claim 4, Kobe discloses that the film further comprises an adhesive disposed on a second surface of the plastic film (*col. 5, line 29 and figure 1*).

Regarding Applicant's claim 5, Kobe discloses that the film further comprises a releasable liner for covering the adhesive prior to use (*col. 5, line 29 and figure 1*).

Regarding Applicant's claims 6-10, the limitation "polished" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. However, the method limitation "polished" does impart structure to the film, which is a flat or non-raised surface. Therefore, Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article. Kobe also meets the limitation the polished surface finish is smooth since figure 1 clearly shows smooth, i.e. flat, portions between the stems. The surface is deemed to be heavily textured (*figure 8*). As seen by figures 8 and 1 the silicone elastomer has textured and polished surface finish.

The limitation "polished surface finish is formed by a casting means having a polished surface finish" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Kobe discloses a surface that is textured and flat.



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Regarding Applicant's claim 11, Kobe discloses that the textured is in an array of upraised dimples (*figures 1 and 8*).

Regarding Applicant's claim 12, the silicone elastomer is deemed to has a matte finish since is contains projections (*figures 1 and 8*).

Regarding Applicant's claim 13, the limitation "wherein the plastic film is heat treated prior to application of the silicone elastomer" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant's claim 14, Kobe discloses that the plastic film has a thickness of about 0.002 inches or less (*col. 5, lines 35-36*).

Regarding Applicant's claims 15-18, Kobe discloses that the plastic film or silicone elastomer can be tinted with pigments or dyes (*col. 5, lines 62-67*). Therefore, either the plastic film or silicone elastomer is deemed to comprises a graphical indicia, since either one may can pigments or dyes.

Regarding Applicant's claims 19-24, the limitations "for application on the fingertips of users," "for application on handheld devices," "for placement onto a material handling device," "for use on equipment used in games" and "configured to be sewn into fabric" are deemed to be statements with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the

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claimed invention from the prior art. MPEP § 2111.02. Furthermore, it is noted that Kobe's article is useful in golf clubs, baseball bats, household articles, non-slip walking surfaces etc. (*col. 1, lines 60-64*). The intended uses of Kobe's article include Applicant's intended uses for their film.

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

10. Applicant's arguments in the response filed April 9, 2007 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ALICIA CHEVALIER  
PRIMARY EXAMINER

*4/25/07*